



AF
ZSW

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Docket No: Q64575

Tsuyoshi INOUE, et al.

Appln. No.: 09/874,314

Group Art Unit: 1771

Confirmation No.: 6107

Examiner: Daniel R. Zirker

Filed: June 06, 2001

For: SHEET FOR PROTECTING PAINT FILM

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellants respectfully submit this Reply Brief in response to the Examiner's Answer dated January 26, 2005. Entry of this Reply Brief is respectfully requested.

Table of Contents

STATUS OF CLAIMS	2
GROUND OF REJECTION TO BE REVIEWED ON APPEAL	3
ARGUMENT	4
CONCLUSION	11

STATUS OF CLAIMS

Claims 1 and 2 are pending in the application.

Claims 1 and 2 are rejected.

Claims 1 and 2 are being appealed.

Claims 1 and 2 were set forth in their entirety in the Claims Appendix submitted with Appellants' Brief on Appeal filed on November 1, 2004.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1 and 2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,643,676 (“Dobashi et al”) in view of EP 0273585 (“EP ‘585”).

ARGUMENT

I. In the *Grounds of Rejection* section of the Examiner's Answer, "the Examiner believed that one of ordinary skill, aware of the wide variety of tackifiers which are suitable for being incorporated into rubber based pressure sensitive adhesives and further aware of the motivation set forth in EP '585 where it is stated that there would be enhanced process of making advantages as well as improved economic and environmental benefits attained from the use of less solvent would accordingly incorporate at least one member of the tackifier subgenus component in place of the closely related subgenus of tackifiers taught in Dobashi et al and thereby inherently form the claimed genus of adhesive sheets." The Examiner further believed that the amount of tackifier recited in present claim 2 is "easily optimized for its intended end purpose by one of ordinary skill in the art." See page 4 of the Examiner's Answer.

In response, Appellants respectfully disagree. The Examiner relied on both the knowledge of one of ordinary skill in the art and the teachings of EP '585 for alleged motivation for the combination. However, the Examiner has not provided any specific factual evidence to conclude that one of ordinary skill is aware that the wide variety of tackifiers are suitable for being incorporated into rubber based pressure sensitive adhesives.

Further, as set forth at pages 9-10 of the Appeal Brief, the Examiner relied on the following statement in EP '585 as providing motivation to combine the tackifier component of EP '585 with the tackifier subgroup disclosed in Col. 9 of the Dobashi et al reference:

With a higher solids content, it would be possible to increase the speed of coating the substrate because there will be less evaporation of solvent to contend with thus increasing the capability of the coating line. The reduction in the amount of

solvent to be evaporated from the coated [sic] also has economic and environmental benefits.

page 2, lines 15 - 18.

This passage clearly indicates that the advantages are achieved by using a higher solids content, i.e., a less amount of solvent, in a rubber based pressure sensitive adhesive solution to be coated onto a substrate. However, EP '585 does not disclose or suggest that the same and/or other advantages are the direct results of incorporation of a particular tackifier.

Accordingly, Appellants respectfully submit that one of ordinary skill in the art would not have been motivated to substitute the tackifier of Dobashi et al with the tackifier disclosed in EP '585. Alternatively, even assuming that there might have been motivation to use the tackifier of EP '585 in the coating film of Dobashi et al, one of ordinary skill in the art would not have reasonably expected attaining improved processability as well as economic and environmental benefits at least in view of the disclosure of EP '585 described above.

II. With respect to the Declaration, the Examiner asserted that it is not given meaningful weight since "what was compared was the no longer relied upon composition of Dobashi et al vs. the two examples of the invention", and also that "the Declaration submits only conclusions in its fouling evaluation test, instead of objective evidence which can be readily analyzed by a disinterested viewer." Pages 4-5 of the Examiner's Answer.

In response, Appellants respectfully disagree. The Declaration was submitted to show the unexpected superiority of the present invention. In the Declaration, a sheet was prepared in the same manner as Example 1 on page 16 of the present specification, except that the terpene

resin of Dobashi et al (YS RESIN PX1150) was used in place of the styrene/hydrogenated terpene copolymer resin (Clearon K100).

The Examiner's position appeared to be that the comparison should be made between the present invention and the combination of Dobashi et al and EP '585, i.e., the tackifier of EP '585 in the coating film of Dobashi et al.

However, it is well established that Applicants are not required to compare the claimed invention with subject matter that does not exist in the prior art. *See* MPEP 716.02(e)(III); *In re Geiger*, 815 F.2d 686, 689, 2 USPQ2d 1276, 1279 (Fed. Cir. 1987); *In re Chapman*, 357 F.2d 418, 148 USPQ 711 (CCPA 1966) (Requiring applicant to compare claimed invention with polymer suggested by the combination of references relied upon in the rejection of the claimed invention "would be requiring comparison of the results of the invention with the results of the invention." 357 F.2d at 422, 148 USPQ at 714).

Further, under MPEP 716.02(b), evidence of unexpected properties may be in the form of a comparison of the claimed invention with the closest prior art which is commensurate in scope with the claims. In the Inoue Declaration, the comparison was made by using the terpene resin, which was used in all of the working Examples in Dobashi et al, the primary reference relied upon by the Examiner, and thus is the closest prior art example. Accordingly, Appellants respectfully submit that the Inoue Declaration satisfies the requirements.

With respect to the fouling evaluation test, as described on page 19 of the specification of the present specification, after the peeling, the paint film was visually examined for fouling. Accordingly, the fouling evaluation results were based on *physical observation*, and not merely conclusory, as asserted by the Examiner.

III. In the *Response to Arguments* section of the Examiner's Answer, the Examiner asserted that Appellants' argument against motivation for the combination and characterization of corresponding representative fields of prior art are extremely narrow. See page 5 of the Examiner's Answer, lines 8-15.

In response, Appellants respectfully disagree. The Dobashi et al reference discloses a film for protecting automobiles during transfer and storage thereof, comprising a substrate made of a colored polyolefin film and a pressure sensitive adhesive layer made of a pressure sensitive adhesive containing as the main component at least one of polyisobutylene, butyl rubber and polybutene. The Dobashi et al inventors sought to solve certain problems of prior art film coatings, including: (1) difficulty of film removal; (2) insufficient durability; and (3) deterioration of the automobile's finish.

The EP '585 reference, which discloses a coated substrate such as an adhesive tape obtained by coating with a solution of a mixture of a rubber and a tackifier dissolved in a solvent. One of the objectives of the EP '585 reference is to balance the competing requirements of high solids concentration (less solvent removal) with low viscosity (coating processability).

In view of the above, the problems and objectives of Dobashi et al and EP '585 are different depending on different end uses. In particular, one of the problems to be solved in Dobashi et al is difficulty of film removal which is of no concern in EP '585.

IV. The Examiner asserted that Appellants' characterization that there is no disclosed utility for EP '585 "clearly ignores the considerable skill of the art pertaining to pressure sensitive adhesive coated sheets and tapes." See page 5 of the Examiner's Answer, lines 15-19.

In response, Appellants respectfully submit that the Examiner has not satisfied his burden to point to any passage in EP '585 which describes particular uses of the invention. Further, the Examiner has not provided any objective evidentiary basis to support his general assertion as to the level of the skill in the art. The deficiency of prior art that lacks stated utility cannot be supplanted simply by reference to a level of ordinary skill.

V. With respect to Appellants' argument that there is no basis for an expectation of success, the Examiner asserted that both references "clearly related to tackifier containing rubber-based pressure sensitive adhesive coated sheets and tapes, and the subgenres of tackifiers taught by each reference are extremely closely related." Pages 5-6 of the Examiner's Answer.

In response, Appellants wish to emphasize that there is no utility for the tapes disclosed in EP '585 and the Examiner has not provided any fact-based evidence to conclude that these tackifiers would function in substantially the same manner so that replacing the resins of the Dobashi et al reference with the tackifiers of EP '585 would result in similar (or better) adhesive properties to (or than) those of Dobashi et al.

VI. The Examiner contested Appellants' statement that "Dobashi et al does not *suggest* the hydrogenated aliphatic/aromatic copolymer petroleum resins, as *the Examiner has conceded*" (emphasis added). See page 6 of the Examiner's Answer, lines 4-9.

In response, Appellants wish to point out that the Examiner conceded that Dobashi et al does not *disclose* the hydrogenated aliphatic/aromatic copolymer petroleum resins. However, the Examiner has provided no factual basis for the "suggestion" based on the Dobashi et al

reference. Indeed the only “suggestion” relied upon by the Examiner is based on the combination of the Dobashi et al and EP ‘585 references.

VII. The Examiner asserted that Appellants’ remarks that solids content, solid removal and environment concerns are not even disclosed in Dobashi et al ignore “the high level of ordinary skill in this environmentally conscious, economic conscious art.” See page 6 of the Examiner’s Answer, lines 9-13.

In response, Appellants wish to point out, again, that the Examiner has not provided any factual evidentiary basis to support his general conclusion. Reference to an “environmentally conscious economic conscious art” is not a replacement for a specific teaching as to solids content and removal. Further, even if one of ordinary skill in the art would consider the environmental and economic issues, he/she would have been motivated to use a high solids content (i.e., less amount of solvent) in the adhesive coating composition in Dobashi et al in view of the teachings of EP ‘585.

VIII. With respect to the tackifier content, the Examiner asserted that the tackifier content for the lightly tacky adhesive sheets of Dobashi et al is not far from the lower level of the range taught in EP ‘585. The Examiner further asserted that Appellants’ argument “totally ignores the level of ordinary skill in the art wherein one would readily aware of the fact that lightly adhering adhesive sheets such as Dobashi et al teaches would naturally have lesser amounts of tackifier than other types of adhesive sheets and tapes for other intended usages, and in which that adhesive tapes of EP ‘585 might well be utilized.” Page 6-7 of the Examiner’s Answer.

Further, the Examiner asserted that present claim 1 does not contain ranges or proportions of a tackifier.

In response, Appellants respectfully disagree. The tackifier content of the Dobashi et al reference is 1-30 parts by weight of the polymer that is the main component of the pressure sensitive adhesive. Dobashi et al further teaches that *“if more than 30 parts by weight, it will undesirably cause blooming of adherends, adhesive transfer on adherends and a decrease in weatherability.”*

In contrast, the ratio of rubber polymer to tackifier resin of EP ‘585 lies between 1:2 and 2:1. Thus, even when employed in the lowest amount disclosed (33.3%), the tackifiers of the EP ‘585 reference are present in a substantially higher content relative to the polymer than the tackifiers of the Dobashi et al reference.

Again, the Examiner has not provided any evidentiary basis to support his general conclusion that using the tackifier content of 33.3 parts by weight of the polymer in Dobashi et al would not cause the problems described in Dobashi et al, because it is not far from the high end of the range taught in Dobashi et al (30 parts by weight of the polymer). The “not far from” standard employed by the Examiner ignores the plain teaching of undesirable results, “if more than” 30 parts by weight tackifier are used.

Appellants’ argument was presented to show that Dobashi et al teaches away from using the tackifier of EP ‘585 in the amounts and thus support the conclusion that a person of ordinary skill would not have a reasonable expectation of success if combining the tackifiers disclosed in the EP ‘585 reference with the coating formulas of Dobashi et al. However, the argument was

not presented to distinguish the present claims from the prior art in terms of the tackifier content.

There is no requirement that the present claims recite any ranges.

VIV. The Examiner asserted that “all Applicants have done is to substitute one subgenus of one of the common ingredients, tackifiers, for an extremely closely related tackifier subgenus taught by another rubber based pressure sensitive adhesive tape and/or sheet teaching reference and by doing so have achieved the expected end result.” Page 7 of the Examiner’s Answer, lines 9-14.

In response, Appellants maintain that the present invention, as claimed, is patentable over the applied references at least based on the previously submitted arguments and the arguments in response to the Examiner’s Answer set forth above.

CONCLUSION

For the above reasons as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner’s rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,



Fang Liu
Registration No. 51,283

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: March 24, 2005